

REMARKS

The Office Action dated April 14, 2006 contained a final rejection of claims 1-48. The Applicant has amended claims 1, 6, 13, 15, 23, 28, 36, 40 and 46. Claims 1-48 are in the case. Please consider the present amendment with the attached Request for Continued Examination (RCE) under 37 C.F.R. § 1.114. This amendment is in accordance with 37 C.F.R. § 1.114. Reexamination and reconsideration of the application, as amended, are requested.

The Office Action rejected claims 1-8, 10-20, 23-34, 36-42, and 44-48 under 35 U.S.C. 103(a) as allegedly being unpatentable over Stumm (U.S. Patent No. 5,768,528) in view of Peterson et al. (U.S. Patent No. 6,594,682). Also, the Office Action rejected claims 9, 21-22, 35, and 43 under 35 U.S.C. 103(a) as allegedly being unpatentable over Stumm in view of Peterson et al. and further in view of Milovanovic et al. (U.S. Patent No. 6,484,198).

The Applicants respectfully traverse these rejections based on the amendments to the claims and the arguments below.

For example, the combination of Stumm et al. with Peterson et al. simply disclose providing information files to a plurality of subscribers over the Internet, wherein a database server maintains a schedule of events file adapted to contain information relating to predetermined downloading schedules to the subscribers of the database server and a client-based system with a scheduling subsystem to schedule a time to obtain the Web content from the server. (see Abstracts of Stumm and Petersen et al.)

In contrast, with regard to claims 1-8, 10-20, 23-34, 36-42, and 44-48, the claimed invention now includes creating a personalized issue number for each issue to be delivered, wherein constant publication-unique information is used to create a random character key to **obfuscate a filename** of the content to prevent users from anticipating upcoming undelivered content and creating a suitably **obfuscated filename** by assembling each issue's filename from an unchanging name portion, concatenated with a fixed number of digits representing the specific issue number. Support for these amendments can be found in FIG. 2 and at the sixth and seventh full paragraphs on page 7 of the Applicants' original specification (lines 21-30).

With regard to claims 9, 21-22, 35, and 43, Stumm combined with Peterson et al. and Milovanovic et al. merely disclose the above with a file locator (see col. 2, lines 10-25 of Milovanovic et al.). The combined references are still missing the Applicants'

random character key based on constant publication-unique information to obfuscate a filename of the content to prevent users from anticipating upcoming undelivered content, wherein the obfuscated filename is created from an unchanging name portion, concatenated with a fixed number of digits representing the specific issue number. Instead, Petersen et al. disclose that "...descriptive information can be used to categorize the Web content...", (see col. 6, lines 17-26 of Petersen et al.).

In addition, these elements have advantages not appreciated by the combined cited references. Namely, as discussed on page 7, lines 20-30, of the Applicants' specification, this arrangement makes "...it almost impossible for a person who knows the URLs of the already-delivered content to deduce the URLs of upcoming issues and look ahead at yet-undelivered, postponed, and/or unpaid for, content."

Further, even though the combined references do not disclose, teach, or suggest the Applicants' claimed invention, the references should not be considered together because Stumm teaches away from the Applicants' invention, as admitted by the Examiner (see page 11 of the April 14, 2006 Office Action). Although the Examiner cited a section from the MPEP regarding considering the reference as a whole, the Examiner's citation is actually in favor of the Applicants' arguments. In fact, MPEP section 2143.01, part V. clearly states that "[I]f proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Also, MPEP section 2143.01, part VI. states that "[I]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

Specifically, Stumm discloses that "...each publisher is allowed to control the times which a subscriber is scheduled to access server system 20." This is the opposite of the Applicants' claimed invention, which allows the subscriber, and not the publisher, to control delivery times and schedules. Instead, Stumm explicitly state that "[T]hus, each publisher is allowed to control the times which a subscriber is scheduled to access server system 20." (see col. 9, lines 20-27 and lines 45-51), which is a teaching away from the Applicants' claimed invention.

Thus, allowing a subscriber to create and control custom delivery schedules would contradict the statement made in col. 9, lines 20-27 and lines 45-51 of Stumm

Consequently, the proposed modification or combination would render the prior art invention being modified unsatisfactory for its intended purpose and would. In addition, as discussed above, the proposed modification or combination would change the principle of operation of the invention in Strumm being modified.

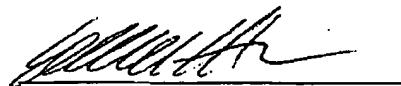
As such, this "teaching away" prevents this reference from being used by the Examiner. ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). Therefore, since the claimed elements of a delivery rule received from the user or subscriber for the content and enabling the subscriber to create and control a custom issue delivery schedule are not disclosed by Strumm and because Strumm, teaches away from the Applicants' invention, Strumm cannot be used as a reference alone in combination with other references in an attempt by the Examiner to render the claims obvious, and hence, the Applicants submit that the rejection should be withdrawn. *MPEP 2143*.

With regard to the rejection of the dependent claims, because they depend from the above-argued respective independent claims, and they contain additional limitations that are patentably distinguishable over the cited references, these claims are also considered to be patentable (*MPEP* § 2143.03).

Thus, it is respectfully requested that all of the claims be allowed based on the amendments and arguments. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. Additionally, in an effort to further the prosecution of the subject application, the Applicants kindly invite the Examiner to telephone the Applicants' attorney at (818) 885-1575 if the Examiner has any questions or concerns. Please note that all correspondence should continue to be directed to:

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Respectfully submitted,
Dated: July 14, 2006



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